PATENT

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Applicant	:	David Allison Bennett, et al.
Application No.:		09/684,871
Filed	:	October 6, 2000
Title	:	APPARATUS, SYSTEMS AND METHODS FOR ONLINE, MULTI-CARRIER, MULTI-SERVICE PARCEL SHIPPING MANAGEMENT FEATURING SHIPPING LOCATION COMPARISON ACROSS MULTIPLE CARRIERS
Technology Center	:	3600
Grp./Div.	:	3629
Examiner	:	Webb, Jamisue A.
Docket No.	:	PSTM0003/MRK

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140 S. Lake Ave., Suite 312
Pasadena, CA 91101-4710
February 13, 2007

APPEAL BRIEF

This is an appeal from a final rejection of the Examiner, dated August 17, 2006, rejecting all claims currently under examination in the case, namely Claims 1-21.

Applicants file this Appeal under 37 C.F.R. §41.31(a), all claims having been twice rejected.

The requisite fee set forth in 37 C.F.R. §41.20(b)(1) for filing a Notice of Appeal was presented with the filing of the Notice of Appeal which was filed via First Class U.S. Mail on November 15, 2006 with a Certificate of Mailing.

The requisite fee set forth in 37 C.F.R. §41.20(b)(2) for filing this Appeal Brief is presented herewith.

A Petition for an Extension of Time for one month and the corresponding fee are filed concurrently herewith. It is respectfully submitted that this Appeal Brief is timely filed under 37 C.F.R. §§ 41.37(a)(1), 41.31(a), 41.31(d) and 1.136, because it is filed before the expiration of February 15, 2007, which is the end date of the one-month

extension period that follows the Section 41.37 two-month period (that ended on January 15, 2007) following the November 15, 2006 filing of the Notice of Appeal.

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PETITION FOR EXTENSION OF TIME UNDER 37 CFR 1.136(a)	Docket Number (Optional) **PSTM0003/MRK**

In re Application of David Allison Bennett, et al.	
Application Number 09/684,871	Filing Date October 6, 2000

For	Apparatus, Systems and Methods for Online, Multi-Carrier, Multi-Service Parcel Shipping Management Featuring...

Art Unit 3629	Examiner Jamisue A. Plucinski

This is a request under the provisions of 37 CFR 1.136(a) to extend the period for filing a reply in the above identified application.

The requested extension and appropriate non-small entity fee are as follows (check time period desired):

[X] One month (37 CFR 1.17(a)(1)) $ 120.00

[ ] Two months (37 CFR 1.17(a)(2)) $ 450.00

[ ] Three months (37 CFR 1.17(a)(3)) $ 1020.00

[ ] Four months (37 CFR 1.17(a)(4)) $ 1,590.00

[ ] Five months (37 CFR 1.17(a)(5)) $ 2,160.00

[ ] Applicant claims small entity status. See 37 CFR 1.27. Therefore, the fee amount shown above is reduced by one-half, and the resulting fee is: $ .00.

[ ] A check in the amount of the fee is enclosed.

[ ] Payment by credit card. Form PTO-2038 is attached.

[ ] The Director has already been authorized to charge fees in this application to a Deposit Account.

[X] The Director is hereby authorized to credit any overpayment or charge any deficiencies to Deposit Account Number 501574. I have enclosed a duplicate copy of this sheet.

I am the

[ ] applicant/inventor.

[ ] assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96).

[X] attorney or agent of record. Registration Number 45,744

[ ] attorney or agent under 37 CFR 1.34(a). Registration number if acting under 37 CFR 1.34(a) _____

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WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

February 13, 2007
_____
Date

(626) 796-2856
_____
Telephone Number

Signature

Marilyn R. Khorsandi
_____
Typed or printed name

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.

[ ] Total of _____ forms are submitted.

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REAL PARTIES IN INTEREST (37 C.F.R. §41.37(c)(1)(i) heading)

In an Assignment, Inventors David Allison Bennett, William W. Smith, III, and Charles D. Mentzer, assigned the entire right, title and interest in and to the instant application to STAMPS.COM INC., as recorded by the Assignment Division of the United States Patent and Trademark Office on March 9, 2001 on Reel No. 011630 and Frame No. 0178. In a subsequent Intellectual Property Joint Ownership Agreement Notice of Assignment, STAMPS.COM INC. noticed the assignment of an undivided whole interest in common in all rights, title, and interest in and to the present application to both STAMPS.COM INC. and ISHIP INC., as recorded by the Assignment Division of the United States Patent and Trademark Office on March 26, 2004 on Reel No. 014466 and Frame No. 0275. Statements by both STAMPS.COM INC. and ISHIP INC. under 37 C.F.R. §3.73(b) are filed concurrently herewith.

ISHIP INC. is a fully owned subsidiary of UNITED PARCEL SERVICE OF AMERICA, INC., which is a fully owned subsidiary of UNITED PARCEL SERVICE, INC.

Accordingly, STAMPS.COM INC., ISHIP INC., UNITED PARCEL SERVICE OF AMERICA, INC., and UNITED PARCEL SERVICE, INC. are the real parties in interest in this case.

RELATED APPEALS AND INTERFERENCES (37 C.F.R. §41.37(c)(1)(ii) heading)

Applicants have not previously presented the current claim set to the Board in an Appeal Brief and there are no related appeals or interferences known to Appellants, or known to Appellants' legal representative, regarding the current claim set.

However, there is an Appeal pending in the case of related U.S. Patent Application No. 09/684,861 (Applicants Bilibin, Paul et al.; Filed October 6, 2000; Entitled "Apparatus, Systems and Methods for Determining Delivery Time Schedules for Each of Multiple Carriers"; Attorney Docket No. PSTM0024/MRK; Technology Center 3600; Group/Div. 3623; Examiner Beth Van Doren). No opinion has yet been rendered in that case.

Further, there is an Appeal pending in the case of related U.S. Patent Application No. 09/680,654 (Applicants David Allison Bennett, et al., Filed October 6, 2000; Entitled

"Apparatus, Systems and Methods for Online, Multi-Carrier, Multi-Service Parcel Shipping Management Featuring Shipping Rate and Delivery Schedule Comparison for Multiple Carriers"; Attorney Docket No. PSTM0015/MRK; Technology Center 3600; Group/Div. 3629; Examiner Jamisue A. Webb). No opinion has yet been rendered in that case.

Yet further, there is an Appeal pending in the case of related U.S. Patent Application No. 09/685,077 (Applicants Paul Bilibin, et al., Filed October 6, 2000; Entitled "Apparatus, Systems and Methods for Online, Multi-Carrier, Multi-Service Parcel Shipping Management Determination of Ratable Weight for Multiple Carrier"; Attorney Docket No. PSTM0020/MRK; Technology Center 3600; Group/Div. 3629; Examiner Jamisue A. Webb). No opinion has yet been rendered in that case.

Further still, there is an Appeal pending in the case of related U.S. Patent Application No. 09/820,377 (Applicants Daniel F. Williams, et al., Filed March 27, 2001; Entitled "Apparatus, Systems and Methods for Online, Multi-Parcel, Multi-Carrier, Multi-Service Enterprise Parcel Shipping Management"; Attorney Docket No. PSTM0041/MRK; Technology Center 3600; Group/Div. 3629; Examiner Jamisue A. Webb). No opinion has yet been rendered in that case.

Prior to filing an Appeal Brief in the case of the above-mentioned pending Appeal for Application No. 09/684,861 (Attorney Docket No. PSTM0024/MRK), a Pre-Appeal Brief Request for Review was filed for that application. A copy of the Notice of Panel Decision from Pre-Appeal Brief Request for Review for Application No. 09/684,861 is included in the Related Proceedings Appendix hereto.

Further, prior to filing an Appeal Brief in the case of the above-mentioned Appeal for Application No. 09/680,654 (Attorney Docket No. PSTM0015/MRK), a Pre-Appeal Brief Request for Review was filed for that application. A copy of the Notice of Panel Decision from Pre-Appeal Brief Review for Application No. 09/680,654 is included in the Related Proceedings Appendix hereto.

Yet further, prior to filing an Appeal Brief in the case of the above-mentioned Appeal for Application No. 09/685,077 (PSTM0020/MRK), a Pre-Appeal Brief Request for Review was filed for that application. A copy of the Notice of Panel Decision from

Pre-Appeal Brief Review for Application No. 09/685,077 is included in the Related Proceedings Appendix hereto.

STATUS OF CLAIMS (37 C.F.R. §41.37(c)(1)(iii) heading)

The present application was filed on October 6, 2000, claiming priority under 37 C.F.R. §1.78(a)(4) to: U.S. Provisional Patent Application Serial No. 60/158,179, filed on October 6, 1999; U.S. Provisional Patent Application Serial No. 60/170,186, filed on December 10, 1999; U.S. Provisional Patent Application Serial No. 60/170,504, filed on December 13, 1999; U.S. Provisional Patent Application Serial No. 60/192,692, filed on March 28, 2000; U.S. Provisional Patent Application Serial No. 60/192,723, filed on March 27, 2000; U.S. Provisional Patent Application Serial No. 60/193,899, filed on March 31, 2000; and U.S. Provisional Patent Application Serial No. 60/195,748, filed on April 6, 2000.

The status of the Claims is as follows:

Allowed Claims: None.

Cancelled Claims: None.

Withdrawn Claims: Claims 11-14 are hereby withdrawn; in accordance with the Manual of Patent Examining Procedure ("MPEP") §1214.05, cancellation of Claims 11-14 is hereby authorized.

Claims objected to: None.

Rejected Claims: 1-21.

Claims on Appeal: 1-10, and 15-21.

STATUS OF AMENDMENTS (37 C.F.R. §41.37(c)(1)(iv) heading)

No amendments subsequent to the final *Office Action*, dated August 17, 2006, have been filed. However, as noted above, Claims 11-14 are hereby withdrawn; in accordance with MPEP §1214.05, cancellation of Claims 11-14 is hereby authorized.

SUMMARY OF CLAIMED SUBJECT MATTER (37 C.F.R. §41.37(c)(1)(v) heading)

The Claims on Appeal are Claims 1-10, and 15-21. Of the Claims on appeal, Claims 1, 2, 3, 8, 9, 10, 15, 16, and 17 are independent. It is respectfully submitted that none of the Claims on appeal are means plus function claims.

In compliance with 37 C.F.R. § 41.37(c)(1)(v), the subject matter of the independent claims on appeal is explained below with citations to the Specification of the present application ("*Specification*") as disclosed with respect to exemplary embodiments. Unless otherwise specified, citations below to the *Specification* are to page and line numbers of the application as originally filed.

Claims 1, 8, and 15

Claim 1 is directed to a shipping management computer system that comprises at least one computer device. Claim 8 is directed to a "...method using a computer system for managing shipping of a plurality of parcels shipped by any one carrier of a plurality of carriers, wherein said computer system comprises at least one computer device...." Claim 15 is directed to a "...computer program product embodying computer program instructions for execution by a computer system for managing shipping of a plurality of parcels shipped by any one carrier of a plurality of carriers ...."

It is respectfully submitted that various exemplary embodiments of the aforementioned recitations of Claims 1, 8 and 15 are described in the Specification. *See, e.g., Specification*, Title; *Specification*, Abstract; *Specification*, p. 16, lines 10-24 (describing FIG. 4).

Claim 1 further recites that the shipping management computer system is programmed to, among other things, "... receive from each respective user of a plurality of users, a respective input of a set of parcel specifications for shipping a respective particular parcel ...." Claims 8 and 15 recite similar limitations. It is respectfully submitted that various exemplary embodiments of the aforementioned recitations of Claims 1, 8 and 15 are described in the Specification. *See, e.g., Specification*, p. 16, line 10 – p. 17, line 10; *Specification*, p. 3, lines 14-17; *Specification*, p. 58, line 26 – p. 59, line 7.

Claim 1 further recites that "… each respective user accesses the shipping management computer system over a global communications network using a respective user client computer device …." Claims 8 and 15 recite similar limitations. It is respectfully submitted that various exemplary embodiments of the aforementioned recitations of Claims 1, 8 and 15 are described in the Specification. *See, e.g.,* *Specification*, p. 15, line 26 – p. 16, line 9.

Claim 1 further recites " … wherein each respective user client computer device is adapted for communication with the global communications network …." Claims 8 and 15 recite similar limitations. It is respectfully submitted that various exemplary embodiments of the aforementioned recitations of Claims 1, 8 and 15 are described in the Specification. *See, e.g., Specification*, p. 3, lines 7-9; *Specification*, p. 12, lines 24-29.

Claim 1 further recites " … in response to each respective input, apply a set of carrier-specific shipping location rules for each carrier of a plurality of carriers to a respective default shipping location associated with the respective user and to the set of parcel specifications input by the respective user …." Claims 8 and 15 recite similar limitations. It is respectfully submitted that various exemplary embodiments of the aforementioned recitations of Claims 1, 8 and 15 are described in the Specification. *See, e.g., Specification*, p. 51, lines 2-8; *Specification*, p. 51, lines 15-27; *Specification*, p. 52, lines 22-26.

Claim 1 further recites " … for each carrier of the plurality of carriers, determine whether the carrier would support shipping of the particular parcel according to the respective set of shipping location rules for the carrier as applied to the parcel specifications for the particular parcel and the respective default shipping location associated with the respective user …." Claims 8 and 15 recite similar limitations. It is respectfully submitted that various exemplary embodiments of the aforementioned recitations of Claims 1, 8 and 15 are described in the Specification. *See, e.g., Specification*, p. 3, lines 2-9; *Specification*, p. 3, lines 18-23; *Specification*, p. 54, lines 13-20.

Claim 1 further recites "… generate a simultaneous online display of a plurality of

delivery services for each carrier of the plurality of carriers that would support shipping of the particular parcel from the respective default shipping location." Claims 8 and 15 recite similar limitations. It is respectfully submitted that various exemplary embodiments of the aforementioned recitations of Claims 1, 8 and 15 are described in the Specification. *See, e.g., Specification*, p. 38, line 3 - p. 39, line 4; *Specification*, p. 45, line 20 - p. 52, line 17.

Claims 2, 9, and 16

Claim 2 is directed to a shipping management computer system that comprises at least one computer device. Claim 9 is directed to "[a] method using a computer system for managing shipping of a plurality of parcels shipped by any one carrier of a plurality of carriers, wherein said computer system comprises at least one computer device ...." Claim 16 is directed to "[a] computer program product embodying computer program instructions for execution by a computer system for managing shipping of a plurality of parcels shipped by any one carrier of a plurality of carriers ..."

It is respectfully submitted that various exemplary embodiments of the aforementioned recitations of Claims 2, 9 and 16 are described in the Specification. *See, e.g., Specification*, Title; *Specification*, Abstract; *Specification*, p. 16, lines 10-24 (describing FIG. 4).

Claim 2 further recites that the shipping management computer system is programmed to, among other things, "... in response to a request by any particular respective user of a plurality of users to ship a particular respective parcel, identify each carrier of a plurality of carriers that would support shipping the particular respective parcel from a respective user-specific default shipping location that is associated with the particular respective user, ..." Claims 9 and 16 recite similar limitations. It is respectfully submitted that various exemplary embodiments of the aforementioned recitations of Claims 2, 9 and 16 are described in the Specification. *See, e.g., Specification*, p. 16, line 10 – p. 17, line 10; *Specification*, p. 3, lines 14-17; *Specification*, p. 58, line 26 – p. 59, line 7; *See also, e.g., Specification*, p. 3, lines 2-9; *Specification*, p. 3, lines 18-23; *Specification*, p. 54, lines 13-20.

With regard to the programming of the shipping management computer system recited in Claim 2, Claim 2 further recites, among other things, "...wherein each carrier of a plurality of carriers that would support shipping the particular respective parcel from the respective user-specific default shipping location is identified according a respective set of shipping location rules for the carrier as applied to the respective default shipping location associated with the respective user, ..." Claims 9 and 16 recite similar limitations. It is respectfully submitted that various exemplary embodiments of the aforementioned recitations of Claims 2, 9 and 16 are described in the Specification. *See e.g.*, *Specification*, p. 3, lines 2-9; *Specification*, p. 3, lines 18-23; *Specification*, p. 54, lines 13-20.

Claim 2 further recites that "...each respective user accesses the computer system over a global communications network using a respective client computer device ...." Claims 9 and 16 recite similar limitations. It is respectfully submitted that various exemplary embodiments of the aforementioned recitations of Claims 2, 9 and 16 are described in the Specification. *See, e.g.*, *Specification*, p. 15, line 26 – p. 16, line 9.

Claim 2 further recites " ... wherein each respective user client computer device is adapted for communication with the global communications network ...." Claims 9 and 16 recite similar limitations. It is respectfully submitted that various exemplary embodiments of the aforementioned recitations of Claims 2, 9 and 16 are described in the Specification. *See, e.g.*, *Specification*, p. 3, lines 7-9; *Specification*, p. 12, lines 24-29.

Claim 2 further recites "...generate a simultaneous online display comprising an identification of a plurality of delivery services for each carrier of the plurality of carriers that would support shipping of the particular respective parcel from the respective user-specific default shipping location." Claims 9 and 16 recite similar limitations. It is respectfully submitted that various exemplary embodiments of the aforementioned recitations of Claims 2, 9 and 16 are described in the Specification. *See, e.g.*, *Specification*, p. 38, line 3 - p. 39, line 4; *Specification*, p. 45, line 20 - p. 52, line 17.

Claims 3, 10, and 17

Claim 3 is directed to a shipping management computer system that comprises at least one computer device. Claim 10 is directed to "[a] method using a computer system for managing shipping of a plurality of parcels shipped by any one carrier of a plurality of carriers, wherein said computer system comprises at least one computer device ...." Claim 17 is directed to "[a] computer program product embodying computer program instructions for execution by a computer system for managing shipping of a plurality of parcels shipped by any one carrier of a plurality of carriers ...."

It is respectfully submitted that various exemplary embodiments of the aforementioned recitations of Claims 3, 10 and 17 are described in the Specification. *See, e.g., Specification*, Title; *Specification*, Abstract; *Specification*, p. 16, lines 10-24 (describing FIG. 4).

Claim 3 further recites that the shipping management computer system is programmed to, among other things, "... collect as a respective default shipping location for a respective particular user of a plurality of users, a user input from the respective particular user of a respective identification of a default shipping location from which respective parcels would be shipped by the respective particular user, ..." Claims 10 and 17 recite similar limitations. It is respectfully submitted that various exemplary embodiments of the aforementioned recitations of Claim 3, 10 and 17 are described in the Specification. *See, e.g., Specification*, p. 3, lines 10-13; *Specification*, p. 24, line 5 – p. 25, line 3.

Claim 3 further recites that "...each respective particular user accesses the computer system over a global communications network using a respective client computer device ...." Claims 10 and 17 recite similar limitations. It is respectfully submitted that various exemplary embodiments of the aforementioned recitations of Claims 3, 10 and 17 are described in the Specification. *See, e.g., Specification*, p. 15, line 26 – p. 16, line 9.

Claim 3 further recites " ... wherein each respective user client computer device is adapted for communication with the global communications network ...." Claims 10 and 17 recite similar limitations. It is respectfully submitted that various exemplary

embodiments of the aforementioned recitations of Claims 3, 10 and 17 are described in the Specification. *See, e.g., Specification*, p. 3, lines 7-9; *Specification*, p. 12, lines 24-29.

Claim 3 further recites " ... store in a database a respective record corresponding to each respective particular user, each said respective record comprising an identifier for the respective particular user, and further comprising the respective identification of the default shipping location for the respective particular user ...." Claims 10 and 17 recite similar limitations. It is respectfully submitted that various exemplary embodiments of the aforementioned recitations of Claims 3, 10 and 17 are described in the Specification. *See, e.g., Specification*, p. 3, lines 10-13; FIGS. 33a-33b and corresponding description at *Specification*, p. 42, line 25 – p. 43, line 27; *Specification*, p. 28, lines 2-15.

Claim 3 further recites that the shipping management computer system is programmed to, among other things, "... for each respective carrier of a plurality of carriers, determine whether the respective carrier would support shipping of a particular parcel according to a respective set of shipping location rules for the respective carrier as applied to the respective default shipping location input by the respective particular user ...." Claims 10 and 17 recite similar limitations. It is respectfully submitted that various exemplary embodiments of the aforementioned recitations of Claims 3, 10 and 17 are described in the Specification. *See, e.g., Specification*, p. 3, lines 2-9; *Specification*, p. 3, lines 18-23; *Specification*, p. 54, lines 13-20.

Claim 3 further recites "... generate a simultaneous online display identifying a plurality of delivery services for each respective carrier of the plurality of carriers that would support shipping of the particular parcel from the respective default shipping location." Claims 10 and 17 recite similar limitations. It is respectfully submitted that various exemplary embodiments of the aforementioned recitations of Claims 3, 10 and 17 are described in the Specification. *See, e.g., Specification*, p. 38, line 3 - p. 39, line 4; *Specification*, p. 45, line 20 - p. 52, line 17.

GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL (37 C.F.R. §41.37(c)(1)(vi) heading)

In the Office Action, Claims 1-21 were rejected under 35 USC 103(a) as being unpatentable over Nicholls et al. (U.S. Patent No. 5,485,369; "*Nicholls*") in view of Kara (U.S. Patent No. 6,233,568; "*Kara*") in further view of Thiel (U.S. Patent No. 5,699,258; "*Thiel*"). For convenient reference, a copy of each of *Nicholls*, *Kara*, and *Thiel* are included in the Evidence Appendix hereto.

In rejecting the Claims under Appeal, namely, Claims 1-10, and 15-21, the Office Action cites Table II at columns 17 and 18 of *Nicholls* to support the proposition that *Nicholls* "… discloses … instruct[ing] [a] computer to … collect … a default location …." *Office Action*, 2d Topic No. 2, p. 2. The Office Action cites column 4, lines 49-55 and column 5, lines 34-40, and columns 25 and 26, line 39 of *Nicholls* to support the proposition that *Nicholls* "… us[es] shipping rules to calculate rates for the shipment." *Office Action*, 2d Topic No. 2, pgs. 2-3. The Office Action posits that "Nicholls discloses using the origin and destination zip codes and zones (column 8, lines 43-55)." *Office Action*, 2d Topic No. 2, p. 3.

The Office Action concludes that "… Nicholls fails to disclose that for each carrier determining whether the carrier would support the shipping of a particular parcel according to rules, and generating a simultaneous display of rates for multiple carriers for a delivery service." *Office Action*, Topic No. 3, p. 3. To compensate for the concluded failing of *Nicholls*, the Office Action takes the position that "Kara discloses simultaneously displaying rates for multiple carriers for a selected delivery service … and discloses the rates are disclosed for those carriers meeting the desired parameters …." *Office Action*, Topic No. 3, p. 3.

In combining *Nicholls* and *Kara*, the Office Action finds that "Kara and Nicholls disclose generating an online display of at least one service of a plurality of carriers …", but concludes that the combination of the *Kara* and *Nicholls* references "… however fails to disclose the simultaneous display of the rates for each carrier for each service." *Office Action*, Topic No. 4, p. 3.

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To compensate for the above-quoted conclusion in the Office Action that the combination of the *Kara* and *Nicholls* references "...fails to disclose the simultaneous display of the rates for each carrier for each service...," the Office Action cites a table in *Thiel* (located at Column 11, lines 1-13 of *Thiel*; sometimes referred to herein as the "*Thiel Table*"). In order to compensate for the stated failing of the combination of *Kara* and *Nicholls*, the Office Action takes the position that the *Thiel Table* "... discloses the use of a system for calculating rates for multiple carriers for multiple services (see abstract), and discloses a simultaneous display of rates for each carrier, that includes rates for different services ...." *Office Action*, Topic No. 4, p. 3. The Office Action further takes the position that "Thiel discloses displaying rates for the preferred carrier, but also discloses displaying the rates for second and third choices as well (Column 11, lines 46-54)." *Office Action*, Topic No. 4, pgs. 3-4.

Issue 1 Regarding the Rejection of Independent Claims 1, 2, 3, 8, 9, 10, 15, 16 and 17, and Therefore Dependent Claims 4-7 and 18-21, Under 35 U.S.C. §103(a) as Unpatentable over Nicholls in View of Kara in further view of Thiel on the Grounds that the Combination of Nicholls, Kara and Thiel Render as Obvious the Limitations of The Claims on Appeal of Determining/Identifying Whether Each Carrier of a Plurality of Carriers Would Support Shipping a Particular Parcel From a Default Shipping Location Associated With a Particular User According to Each Carrier's Shipping Location Rules

Issue 2 Regarding the Rejection of Independent Claims 1, 2, 3, 8, 9, 10, 15, 16 and 17, and Therefore Dependent Claims 4-7 and 18-21, Under 35 U.S.C. §103(a) as Unpatentable over Nicholls in View of Kara in further view of Thiel on the Grounds that the Combination of Nicholls, Kara and Thiel Render as Obvious the Limitations of The Claims on Appeal of Generating a Simultaneous Online Display of a Plurality of Delivery Services for Each Carrier of a Plurality of Carriers That Would Support Shipping a Particular Parcel From a Default

Shipping Location Associated With a Particular User According to Each Carrier's Shipping Location Rules

ARGUMENT (37 C.F.R. §41.37(c)(1)(vii) heading)

> **_Issue 1 Argument Regarding the Rejection of Independent Claims 1, 2, 3, 8, 9, 10, 15, 16 and 17, and Dependent Claims 4-7 and 18-21 Under 35 U.S.C. §103(a) as Unpatentable over Nicholls in View of Kara in further view of Thiel: There is No Disclosure in Nicholls, Kara or Thiel of Determining Whether Each Carrier of a Plurality of Carriers Would Support Shipping a Particular Parcel From a Default Shipping Location Associated With a Particular User According to Each Carrier's Shipping Location Rules (37 C.F.R. §41.37(c)(1)(vii) subheading)_**

It is respectfully asserted, for the reasons given and under the authorities cited below, that the rejections of the Claims on Appeal do not meet the requirements for an obviousness rejection under 35 U.S.C. Section 103(a), as those requirements are explained in MPEP §§706.02(j) and MPEP §2143. Specifically, it is respectfully asserted that none of _Nicholls_, _Kara_ or _Thiel_, whether considered alone or in combination, disclose, anticipate, teach or suggest determin[ing] whether each carrier would (as recited by, _e.g._, independent Claims 1, 3, 8, 10, 15 and 17), or identify[ing] each carrier that would (as recited by, _e.g._, independent Claims 2, 9, and 16), support shipping a particular parcel from a particular shipping location according to the respective carrier's shipping location rules, which is claimed in one way or another, by independent Claims 1, 2, 3, 8, 9, 10, 15, 16 and 17.

> **_ISSUE 1A ARGUMENT REGARDING THE REJECTION OF INDEPENDENT CLAIMS 1, 2, 3, 8, 9, 10, 15, 16 AND 17, AND DEPENDENT CLAIMS 4-7 AND 18-21 UNDER 35 U.S.C. §103(A) AS UNPATENTABLE OVER NICHOLLS IN VIEW OF KARA IN FURTHER VIEW OF THIEL-- CLAIM LANGUAGE INTERPRETATION: SHIPPING LOCATION; DEFAULT SHIPPING LOCATION; DETERMINE ... ACCORDING TO SHIPPING LOCATION RULES FOR THE CARRIER (37 C.F.R. §41.37(c)(1)(vii) subheading)_**

It is respectfully asserted, for the reasons given and authorities cited below, that the claimed terms "shipping location" and "default shipping location" are distinguished from the various shipping feature considerations and shipping rate calculation factors disclosed by the references of record. Moreover, it is respectfully asserted, for the reasons given and the authorities cited below, that the limitations of the Claims on Appeal to determine whether each carrier would (as recited by, *e.g.*, independent Claims 1, 3, 8, 10, 15 and 17), or identify each carrier that would (as recited by, *e.g.*, independent Claims 2, 9, and 16), support shipping a particular parcel from a particular shipping location according to the respective carrier's shipping location rules are patentably distinguished from the references of record.

To ascertain the meaning of the terms "shipping location," "default shipping location," and "determine … according to [a carrier's] shipping location rules" as those terms are used in the Claims, it is proper to consider the Specification of the present patent application. *See, e.g.,* <u>Markman v. Westview Instruments, Inc.</u>, 52 F.3d 967, 979, 34 U.S.P.Q.2D (BNA) 1321, 1329 (Fed. Cir. 1995) (*in banc*), *aff'd*, 517 U.S. 370 (1996) ("To ascertain the meaning of claims, we consider three sources: The claims, the specification, and the prosecution history." (citations omitted)).

It is respectfully asserted that, according to the Specification of the present application, the term "shipping location" recited by the independent claims of the Claims on Appeal (namely, by Claims 1-3, 8-10, and 15-17) is properly interpreted to mean a location from which a User will ship a package. *See, e.g.,* <u>Specification</u>, p. 24, lines 7-10.

Further, it is further respectfully asserted that, according to the Specification of the present application, that the term "default shipping location" recited in some of the Claims on Appeal is properly interpreted to mean "…a default location … from which the User will typically ship packages …." <u>Specification</u>, p. 24, lines 7-10.

Still further, it is respectfully asserted that the phrase "determine whether [a carrier] would support shipping [of a particular] parcel … according to [a carrier's] shipping location rules … as applied to the parcel specifications for the particular parcel and the respective … shipping location associated with the … user" is properly

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interpreted to mean applying the rules by which a particular Carrier would determine whether or not the particular Carrier would support shipping a particular parcel from a particular user's shipping location and determining whether, according to the application of the Carriers rules, the Carrier would support shipping the particular parcel from the particular user's shipping location. *See, e.g., Specification*, p. 2, lines 21-22 ("… Carrier pickup and drop-off shipping location rules can differ by city, state, and zip code and to some extent, parcel specifications for the parcel to be shipped."); *Specification*, p. 2, lines 23-24 (explaining that, in order to identify whether a particular Carrier would ship a particular parcel from a particular shipping location, a "…Shipper must determine each Carrier's pickup and drop-off shipping location rules for the Shipper's own physical location as applied to the particular parcel to be shipped.")

In light of the above-explained meaning of the claimed terms "shipping location," "default shipping location," and "determine … according to …", it is respectfully asserted that a disclosure by a reference of an indication of an identification of delivery services that would support shipping a parcel that does not include consideration of the relevant Carrier's shipping location rules as applied to a particular parcel's specifications and as applied to a particular shipper's shipping location does not disclose, anticipate, teach or suggest the limitations of the Claims on Appeal to determine whether each carrier would (*e.g.*, independent Claims 1, 3, 8, 10, 15 and 17), or identify each carrier that would (e.g., independent Claims 2, 9, and 16), support shipping a particular parcel from a particular shipping location according to the respective carrier's shipping location rules. For the reasons given and the authorities cited below, it is respectfully asserted that the references cited by the Office Action, even when considered in combination, do nothing more than disclose an indication of an identification of delivery services that would support shipping a parcel; they do not disclose, anticipate, teach or suggest consideration of the relevant Carrier's shipping location rules as applied to a particular parcel's specifications and as applied to a particular shipper's shipping location in the manner claimed by the Claims on Appeal.

ISSUE 1B REGARDING THE REJECTION OF INDEPENDENT CLAIMS 1, 2, 3, 8, 9, 10, 15, 16 AND 17, AND DEPENDENT CLAIMS 4-7 AND 18-21 UNDER 35 U.S.C. §103(A) AS UNPATENTABLE OVER NICHOLLS IN VIEW OF KARA IN FURTHER VIEW OF THIEL: THERE IS NO DISCLOSURE IN NICHOLLS, KARA OR THIEL OF DETERMINING OR IDENTIFYING EACH CARRIER OF A PLURALITY OF CARRIERS THAT WOULD SUPPORT SHIPPING A PARTICULAR PARCEL FROM A PARTICULAR SHIPPING LOCATION ASSOCIATED WITH A PARTICULAR USER ACCORDING TO EACH CARRIER'S SHIPPING LOCATION RULES(37 C.F.R. §41.37(c)(1)(vii) subheading)

It is not disputed that some of the references of record disclose in one form or another, shipment rate calculations that consider in one form or another, zone information. Neither is it disputed that some of the references of record collect input of a user's return address and/or a destination zone.

What is disputed is the proposition that cited-reference-consideration of zone information in zone-based shipping rate calculations and/or collection of a return address zip code on the one hand, discloses, anticipates, teaches or suggests determining or identifying carrier support for shipping a particular parcel from a particular shipping location for a particular user according to the respective carrier's shipping location rules, which is claimed in one way or another, by independent Claims 1, 2, 3, 8, 9, 10, 15, 16 and 17 (the "Claims on Appeal") on the other hand.

The Office Action posits that *Nicholls* "... us[es] shipping rules to calculate rates for the shipment ..." (*Office Action*, 2d Topic No. 2, pgs. 2-3) and that "Nicholls discloses using the origin and destination zip codes and zones (column 8, lines 43-55)." *Office Action*, 2d Topic No. 2, p. 3. Notably, the disclosure of *Nicholls* that is relevant to zone-based pricing that is cited in the Office Action for support of the posited use by *Nicholls* of origin and destination zip codes and zones explains that "[a]djustments may be qualified by *destination* [emphasis added](either zone, postal code or destination country) and by weight range." *Nicholls*, col. 8, lines 50-52. That is, the cited *Nicholls* disclosure mentions only *destination* zone, not *origin* zone. Moreover, the cited *Nicholls* disclosure makes no mention of shipping location, or of applying each carrier's shipping

location rules to the parcel specifications for a particular parcel and a particular shipping location.

In order to compare the disclosure of *Nicholls* to the limitations claimed by the Claims on Appeal regarding applying each carrier's shipping location rules to a particular parcel and a particular user's shipping location, it is respectfully asserted that the specification of *Nicholls* is instructive. It is respectfully submitted that *Nicholls* discloses a "client process" that "... has a preprogrammed set of rules which are reflective of a given shipper's predefined set of shipping requirements. The client process also has a processing means for using the preprogrammed set of rules and using at least a portion of the input information to issue request messages to one or more rate servers and to interpret response messages received from the rate servers in order to provide the output information." *Nicholls*, col. 2, lines 31-38.

For reasons explained in more detail below, it is respectfully asserted that, in view of the above-quoted disclosure of *Nicholls*, when read together with other disclosures of *Nicholls*, the disclosed *Nicholls* system does not make any determination or identification of each carrier's support for shipping a particular parcel from a particular shipping location according to the respective carrier's shipping location rules, which is claimed, in one way or another, by the Claims on Appeal. Rather, it is respectfully asserted that the above-quoted disclosure of *Nicholls*, when read together with other disclosures of *Nicholls*, is evidence that, at most, *Nicholls* is preprogrammed to observe carrier-specific shipping location rules for a user for which a *Nicholls* system is installed.

It is respectfully asserted that further evidence that, at most, *Nicholls* is preprogrammed to observe carrier-specific shipping location rules for a user for which a *Nicholls* system is installed can be found in the disclosure by *Nicholls* that "[s]hown in FIG. 4A, the Shipments client accepts user input for routing, rating and documentation of a group of packages comprising a shipment." *Nicholls*, col. 7, lines 53-55. "Multiple

shipper accounts are allowed and the desired account may be selected from the Shipper 'drop-box."[1] *Nicholls*, col. 7, lines 55-57.

It is respectfully asserted that yet further evidence that, at most, *Nicholls* is preprogrammed to observe carrier-specific shipping location rules for a user for which a *Nicholls* system is installed can be found in the disclosure by *Nicholls* under the subtitle "Shipper Maintenance" (*Nicholls*, cols. 17-18, approximately line 37) and the statements that follow that:

> All of these commands deal with the master list of shippers. Clients can access the master list via ENUM. An announcement is sent when any shipper information of any kind changes. This allows other programs to know when they need to do another ENUM – especially if they are storing additional shipper information in parallel with this master list.

Nicholls, cols. 17-18, approximately lines 38-43. Under the above-quoted description of the ENUM command is a listing of data elements for shippers. Included in the listing of shipper data elements is the element named "SHPNA", described as "name/address." *Nicholls*, cols. 17-18, approximately line 63.

It is respectfully asserted that still further evidence that, at most, *Nicholls* is preprogrammed to observe carrier-specific shipping location rules for a user for which a *Nicholls* system is installed can be found in the disclosure by *Nicholls* that "[t]hese client applications may be customized to conform quite closely to a given shipper's operation. These client applications call upon the necessary rate servers, as needed, for the appropriate shipping rates and shipping requirements of the selected carrier." *Nicholls*, col. 4, lines 58-62.

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[1] It is respectfully asserted that the reference in the above-quoted citation from *Nicholls* to a "Shipper 'drop-box'" refers to the input field labeled "Shipper" shown in FIG. 4A and the associated pull-down menu button -- in a typical online system, clicking a pull-down menu button will cause a pull-down menu to appear – the reference to the "Shipper 'drop-box'" is respectfully asserted to refer to the pull-down menu associated with the "Shipper" field and is not relevant to a "drop-off" shipping location as described in the Specification of the present application.

It is respectfully asserted that the above-quoted disclosures of <u>Nicholls</u>, when read together, are evidence that the system of <u>Nicholls</u> does not make any determination or identification of each carrier's support for shipping a particular parcel from a particular shipping location, which is claimed, in one way or another, by the Claims on Appeal.

Although not referenced by the Office Action, *Kara* also discloses zone-based shipping rate considerations. *See, e.g., <u>Kara</u>*, col. 21, lines 60-67 (explaining that "... zone information may be utilized in determining the availability of a particular delivery service, such as overnight, certified, or the like, available from particular ones of the shipping service providers."); <u>Kara</u>, col. 22, lines 13-16 (disclosing that the "... program will automatically incorporate the ... parameters – weight, class, zone – in order to correctly calculate the correct postage ..."); <u>Kara</u>, FIG. 7, element 714 (labeled "Zone – select from box: Local, 1 to 8, Canada, Mexico or International"). It is respectfully asserted that the "Zone" element 714 described in *Kara* is associated with the destination for a mail piece, as reflected in the description of element 714 in FIG. 7 of *Kara* ("... Local, 1 to 8, Canada, Mexico or International ...").

Further, although not referenced by the Office Action, *Thiel* also discloses zone-based shipping rate considerations. *See, e.g., <u>Thiel</u>*, col. 8, line 39 through col. 9, line 10 (disclosing zone-based pricing). *Thiel* describes that:

> Every postal rate table for a national postal system is divided into zones for sending mail from the place of origin, in other words the post office to which the mailbox where the mail is dropped off is assigned, to the receiving location to which the mail to which postage is to be applied will be sent. The zones, which are associated with distances and/or assigned to domestic vs. foreign locations, or the distance from the place of origin to the receiving location may be stored in memory as a supplementary function in such a way that it can be called up and ascertained in a further memory region A, B, C, etc., for each country, and the appropriate zone in the current table is addressed by the control means (FIGS. 3a-3c). Once the correct zone has been determined, the postal customer can make a selection from among the services agree upon among the various

national postal systems and the postage machine manufacturer, in terms of class

of mail ..., the type of shipment ..., and additional services ....

It is not disputed that a particular shipping location may have a particular address and may be within a particular zone. However, for the reasons outlined below, it is respectfully asserted that the limitation "shipping location" recited by the Claims on Appeal is distinguished from a designation of a zone and from a user's address, also sometimes referred to as a user's return address.

The Specification of the present application describes an exemplary embodiment of an input collection screen for collecting a user's address:

> FIG. 12 is a graphic representation depicting an exemplary embodiment of a
> User address collection screen. As depicted in FIG. 12, the System prompts the
> User to provide the User's name 106, e-mail address 107, company name 108,
> street address 109, floor/room number 110, department name 111, city 112,
> state 113a (using a pull down menu button 113b), telephone number 114, zip
> code 115, and fax number 116.

Specification, p. 23, lines 19-23. However, in addition to the user's address, the Specification of the present application also describes exemplary embodiments of a "Shipping Location screen" (as depicted in, *e.g.*, FIGS. 13 and 15 of the present application) in which a user can input a default shipping location from which the user will ship parcels. *See Specification*, p. 24, lines 5-25.

As compared to zone-based rate calculations as disclosed in *Nicholls* and as posited by the Office Action as rendering the claimed limitations obvious (and as disclosed in one way or another in both *Thiel* and *Kara*), it is respectfully asserted that the limitations claimed in one way or another by the Claims on Appeal of determining or identifying carriers that would support shipping a particular parcel from a particular shipping location could provide different results than the disclosures of the references of record, and are therefore distinguished from zone-based rate calculations.

As explained in the Specification of the present application, "... Carrier pickup and drop-off shipping location rules can differ by city, state, and zip code and to some

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extent, parcel specifications for the parcel to be shipped." *Specification*, p. 2, lines 21-22. In order to identify whether a particular Carrier would ship a particular parcel from a particular shipping location, a "...Shipper must determine each Carrier's pickup and drop-off shipping location rules for the Shipper's own physical location as applied to the particular parcel to be shipped." *See Specification*, p. 2, lines 23-24.

The Specification of the present application further explains that "...each Carrier's shipment pricing may differ according to shipping location." *Specification*, p. 2, line 25; *Specification*, p. 63, lines 11-20 (explained with respect to an exemplary embodiment, "...the System then determines whether the Shipper has requested a "Call for Pickup" shipping location .... If so, the System accesses the Carrier Database ... to determine whether the particular Carrier/Service supports "Call for Pickup" services ... If the particular Carrier/Service does not support "Call for Pickup" services, [t]hen the particular Carrier/Service is eliminated from the delivery rate set ... and the System proceeds with the next Carrier/Service in the delivery rate set ... If the particular Carrier/Service supports "Call for Pickup" services, the System adds the appropriate charge for the "Call for Pickup" service to each of the particular Carrier/Service's delivery rates ....").

It is respectfully asserted that although the references of record mention consideration of zone information, there is no mention in any of the references of record of any distinction between Carriers and/or Services as to differences in support, and/or rates, for different shipping locations, including different shipping locations that may exist within a single zone.

For the above-given reasons and authorities, in view of the above-described distinctions between the disclosures of *Nicholls*, *Kara* and *Thiel* on the one hand, and independent Claims 1, 2, 3, 8, 9, 10, 15, 16 and 17, and therefore the Claims dependent on independent Claims 1, 2, 3, 8, 9, 10, 15, 16 and 17, namely, dependent Claims 4-7 and 18-21, it is respectfully requested that the rejection of Claims 1-10 and 15-21 be reversed.

> **_Issue 2 Argument Regarding the Rejection of Independent Claims 1, 2, 3, 8,_**
> **_9, 10, 15, 16 and 17, and Dependent Claims 4-7 and 18-21 Under 35 U.S.C._**
> **_§103(a) as Unpatentable over Nicholls in View of Kara in further view of_**
> **_Thiel: There is No Disclosure in Nicholls, Kara or Thiel of Generating a_**
> **_Simultaneous Online Display of a Plurality of Delivery Services for Each_**
> **_Carrier of a Plurality of Carriers That Would Support Shipping a Particular_**
> **_Parcel From a Default Shipping Location Associated With a Particular User_**
> **_According to Each Carrier's Shipping Location Rules (37 C.F.R._**
> **_§41.37(c)(1)(vii) subheading)_**

It is respectfully asserted, for the reasons given and under the authorities cited below, that the rejections of the Claims on Appeal do not meet the requirements for an obviousness rejection under 35 U.S.C. Section 103(a), as those requirements are explained in MPEP §§706.02(j) and MPEP §2143. Specifically, it is respectfully asserted that none of *Nicholls*, *Kara* or *Thiel*, whether considered alone or in combination, disclose, anticipate, teach or suggest generating a simultaneous online display of, or comprising an identification of, a plurality of delivery services for each carrier of a plurality of carriers that would support shipping of a particular parcel from a default shipping location associated with a particular user of a plurality of users that each access the subject computer system over a global communications network using a user client computer device, which is claimed in one way or another, by independent Claims 1, 2, 3, 8, 9, 10, 15, 16 and 17.

In rejecting independent Claims 1, 2, 3, 8, 9, 10, 15, 16 and 17 of the present application, the Office Action cited, among other things, column 11, lines 1-25 of *Thiel* (which provides a table at Col. 11, lines 1-13 (the "*Thiel Table*")), to support the conclusion that *Thiel* discloses, among other things, "... the use of a system for calculating rates for multiple carriers for multiple services ... and discloses a simultaneous display of rates for each carrier, that includes rates for different services...." *Office Action*, Topic No. 4, p. 3.

However, for the reasons given below, it is respectfully submitted that nothing in *Thiel*, including the cited *Thiel Table*, discloses "... the use of a system for calculating rates for multiple carriers for multiple services ... and discloses a simultaneous display

of rates for each carrier, that includes rates for different services..." as was posited in the Office Action (*Office Action*, Topic No. 4, p. 3.).

In comparing the disclosures of *Thiel* with the limitations of the Claims on Appeal, it is respectfully asserted that the specification of *Thiel* is instructive. More specifically, *Thiel* discloses a system, method and device for franking postal matter (applying postage to mail). *Thiel*, Abstract. *Thiel* discloses a comparison and display of shipping costs (*e.g., Thiel*, col. 6, lines 53-55) by multiple carriers based on a user first selecting a type of shipment (express, air, priority, general, etc.) (*e.g., Thiel*, col. 8, lines 58-66). *Thiel* explains that "[o]nce the weight and the type of mail and shipment form of the mail have been entered, the postage corresponding to the zones can be found automatically" *Thiel*, col. 9, lines 1-3. However, for the reasons described in more detail below, and under the authorities cited below, *Thiel* does not disclose a simultaneous display of a plurality of delivery services for each carrier of a plurality of carriers that would support shipping a particular parcel from a particular shipping location as claimed in one way or another by independent Claims 1, 2, 3, 8, 9, 10, 15, 16 and 17.

In comparing the cited *Thiel Table* to both the features attributed to it in the Office Action, and more importantly, to the claimed limitations of the rejected Claims, it is respectfully asserted that the contents of the cited *Thiel Table* and the description by *Thiel* of the use of the cited *Thiel Table* as described by *Thiel* are instructive.

At first glance, the cited *Thiel Table* may appear to provide a shipping rate comparison. However, it is respectfully submitted that under close inspection, the cited *Thiel Table* provides a stored, not displayed (as claimed in one way or another by the Claims on Appeal), comparison of base rate components, not of calculated shipping rates (as claimed by some of the Claims on Appeal). Further, it is respectfully submitted that the cited *Thiel Table* provides a stored, not displayed (as recited by the Claims on Appeal), comparison of Carriers that are supported by the *Thiel* system, as compared to a comparison of Services by Carriers that would support shipping a particular parcel (as claimed in one way or another by the Claims on Appeal).

More specifically, the cited *Thiel Table* is shown as containing shipping feature entries for five (5) different carriers. See *Thiel*, col. 11, lines 1-13. For each of the five

(5) different carriers (Carrier 1-5), the cited *Thiel Table* shows a shipping feature entry for each of the following shipping features: Destination Zone, Base Charge, Express Delivery, Added [Express Delivery] Charge, Return Receipt, Added [Return Receipt] Charge, Discount for greater than 100 items, Discount for greater than 1000 items, and Discount for greater than 10000 items. *Id.* at col. 11, lines 1-13.

As compared to *calculating rates* for multiple carriers for multiple services for a *simultaneous display* of rates for multiple services for multiple carriers as was posited in the Office Action (*Office Action*, Topic No. 4, p. 3) (and as is claimed in one way or another in dependent Claims 7 and 21 as discussed further below), it is respectfully submitted that *Thiel* describes the cited *Thiel Table* as a *stored* table of services and fee components of various carriers. Further, *Thiel* explains that the cited stored *Thiel Table* is used by the *Thiel* system to "... search[] the carriers which offer the desired services ... " (*Thiel*, col. 11, lines 22-23) and "... [perform] a fee optimization ... to reach the best price ..." (*Thiel*, col. 11, lines 29-30). That is, the cited *Thiel Table* is used by the *Thiel* system to identify carriers that would provide a user-pre-selected delivery service and user-requested shipping features and to calculate shipping rates for shipping a parcel; the cited *Thiel Table* does not contain calculated shipping rates for shipping a parcel.

Further, as compared to the cited *Thiel Table* comprising a "simultaneous display" as was posited in the Office Action (*Office Action*, Topic No. 4, p. 3), *Thiel* describes the cited *Thiel Table* as a *stored* table (not as a displayed table) of services and fees of various carriers. *Thiel*, col. 10, lines 65-67. Yet further, as compared to a *simultaneous [ ] display* of a plurality of delivery services for each carrier of a plurality of carriers that would support shipping a particular parcel from a [particular] shipping location as claimed in one way or another in each of independent Claims 1, 2, 3, 8, 9, 10, 15, 16 and 17, it is respectfully submitted that there is no disclosure in *Thiel* of displaying the cited stored *Thiel Table* to a *Thiel* user. Further, it is respectfully submitted that the above-outlined description of the cited *Thiel Table* discloses a stored comparison of Carriers that are supported by the *Thiel* system, as compared to an identification, determination or comparison of Carriers that would support shipping a particular parcel (as claimed in one way or another by the Claims on Appeal).

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Still further, in positing that the limitation recited, for example, by Claim 1, to generate a simultaneous online display of a plurality of delivery services for each carrier of [a] plurality of carriers that would support shipping of [a] particular parcel from [a]... default shipping location ..." is obvious in view of *Thiel*, the Office Action posits that "Thiel discloses displaying rates for the preferred carrier, but also discloses displaying the rates for second and third choices as well (Column 11, lines 46-54)." *Office Action*, Topic No. 4, pgs. 3-4.

As disclosed in *Thiel* at column 11, lines 46-54, there is no dispute that *Thiel* discloses displaying a calculated rate for a preferred carrier, and for a second and a third carrier as well. However, it is respectfully submitted that the disclosure of *Thiel* cited in support of the aforementioned proposition (*Thiel* at column 11, lines 46-54) when read together with the rest of the *Thiel* specification, explains that after the system disclosed in *Thiel* uses the shipping fee components stored *Thiel* *Table* to calculate shipping rates for a user-pre-selected delivery service level for carriers that would support shipping a parcel according to the user's pre-selected requirements, *Thiel* discloses providing a comparison and display of shipping costs (*e.g., Thiel*, col. 6, lines 53-55) only by multiple *carriers* (*see, e.g., Thiel*, col. 8, lines 58-66), not for a plurality of delivery services for each carrier that would support shipping a particular parcel as claimed in one way or another by independent Claims 1-3, 8-10 and 15-17.

Yet further, it is respectfully submitted that the disclosure of *Thiel* cited in support of the aforementioned proposition (*Thiel* at column 11, lines 46-54) when read together with the rest of the *Thiel* specification, explains that *Thiel* only discloses a comparison and display of shipping costs (*e.g., Thiel*, col. 6, lines 53-55) by multiple carriers based on a user first selecting a type of shipment (express, air, priority, general, etc.; referred to in the Claims on Appeal as a delivery service). *See, e.g., Thiel*, col. 8, lines 58-66; see also, e.g., *Thiel*, col. 11, lines 15-18 (explaining that "[t]he user of the franking machine first defines the required services. This is done by entering the data with regard to the ship-to-zone (the destination zone) and the desired additional services such as express delivery (E), return receipt (R), etc.").

For the following reasons, it is respectfully asserted that providing a comparison display of a plurality of delivery services for each carrier of a plurality of carriers that would support shipping of a particular parcel as claimed in one way or another by independent Claims 1-3, 8-10 and 15-17 is distinguished from, is more useful than, and is patentable over, a display of shipping rates calculated according to a user-pre-selected delivery service level. As compared to the limitations claimed by the Claims on Appeal, a user of the system disclosed by *Thiel* would need to pre-select a delivery service level, for example, Express delivery, and would then be provided with a comparison of shipping rates by carriers that would provide that delivery service level. As compared to the system disclosed by *Thiel*, various embodiments of the limitations claimed by the Claims on Appeal, on the other hand, would provide a comparison display of delivery services for each carrier that would support shipping a parcel from a shipping location associated with the particular user.

For the above-given reasons and authorities, in view of the above-described distinctions between the disclosures of *Nicholls*, *Kara* and *Thiel* on the one hand, and independent Claims 1, 2, 3, 8, 9, 10, 15, 16 and 17, and therefore the Claims dependent on independent Claims 1, 2, 3, 8, 9, 10, 15, 16 and 17, namely, dependent Claims 4-7 and 18-21, it is respectfully requested that the rejection of Claims 1-10 and 15-21 be reversed.

ISSUE 2A ARGUMENT REGARDING THE REJECTION OF DEPENDENT CLAIMS 7 AND 21 UNDER 35 U.S.C. §103(A) AS UNPATENTABLE OVER NICHOLLS IN VIEW OF KARA IN FURTHER VIEW OF THIEL: THERE IS NO DISCLOSURE IN NICHOLLS, KARA OR THIEL OF CALCULATING A SHIPPING RATE BY EACH SERVICE OF A PLURALITY OF SERVICES FOR EACH CARRIER OF A PLURALITY OF CARRIERS FOR SHIPPING A PARTICULAR PARCEL ACCORDING TO EACH CARRIER'S SHIPPING LOCATION RULES AND PRICING RULES AS APPLIED TO THE SHIPPING LOCATION OF THE SHIPPING USER (37 C.F.R. §41.37(c)(1)(vii) subheading)

Dependent Claim 7 recites "... calculate a respective service-specific, carrier-specific shipping rate for shipping the particular parcel for each respective service of a plurality of services offered by each respective carrier of the plurality of carriers, said

respective service-specific, carrier-specific shipping rate calculated according to the respective set of shipping location rules for each respective carrier, and according to a respective set of pricing rules for each respective service offered by each respective carrier as applied to the parcel specifications for the particular parcel and the respective default shipping location." Dependent Claim 21 recites similar limitations.

It is respectfully asserted, for reasons similar to those described above regarding independent Claims 1-3, 8-10 and 15-17, that none of the cited references disclose the above-recited limitation of Claims 7 and 21. Specifically, as compared to *Thiel* *calculating rates* for multiple carriers for multiple services as was posited in the Office Action (*Office Action*, Topic No. 4, p. 3), and which is claimed by dependent Claims 7 and 21, it is respectfully submitted that *Thiel* describes the cited *Thiel Table* as a *stored* table of services and fee components of various carriers. Further, *Thiel* explains that the cited stored *Thiel Table* is used by the *Thiel* system to "... search[] the carriers which offer the desired services ... " (*Thiel*, col. 11, lines 22-23) and "... [perform] a fee optimization ... to reach the best price ..." (*Thiel*, col. 11, lines 29-30). That is, the contents of the stored cited *Thiel Table* are used by the *Thiel* system to identify carriers that would provide requested shipping features and to calculate shipping rates for only the user-pre-selected service level and for the carriers that would provide the requested shipping features.

As compared to the limitation of dependent Claims 7 and 21, it is respectfully submitted that the cited *Thiel Table* does not contain calculated shipping rates for shipping a particular parcel. Moreover, it is respectfully asserted that *Thiel* does not disclose calculating a rate for each service offered by each carrier that would support shipping a particular parcel, but rather discloses only calculating rates for a user-pre-selected service level.

For the above-given reasons and authorities, in view of the above-described distinctions between the disclosures of *Nicholls*, *Kara* and *Thiel* on the one hand, and dependent Claims 7 and 21 on the other hand, it is respectfully requested that the rejection of Claims 7 and 21 be reversed.
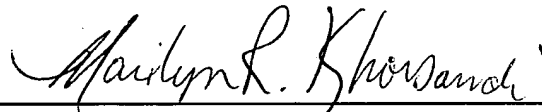
ARGUMENT CONCLUSION

For the above-given reasons and authorities, in view of the above-described distinctions between the disclosures of *Nicholls*, *Kara* and *Thiel* on the one hand, and independent Claims 1, 2, 3, 8, 9, 10, 15, 16 and 17, and therefore the Claims dependent on independent Claims 1, 2, 3, 8, 9, 10, 15, 16 and 17, namely, dependent Claims 4-7 and 18-21, it is respectfully requested that the rejection of Claims 1-10 and 15-21 be reversed.

Respectfully submitted,

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CLAIMS APPENDIX (37 C.F.R. §41.37(c)(1)(viii) heading)

(Double-Spaced as required by MPEP §1205.02)

THE CLAIMS ON APPEAL ARE THE PENDING CLAIMS AFTER THE AMENDMENT AND RESPONSE FILED OCTOBER 31, 2005 IN RESPONSE TO THE OFFICE ACTION DATED AUGUST 1, 2005, AND ARE AS FOLLOWS:

1.   A shipping management computer system, said shipping management computer system comprising at least one computer device, wherein said shipping management computer system is programmed to:

receive from each respective user of a plurality of users, a respective input of a set of parcel specifications for shipping a respective particular parcel, wherein each respective user accesses the shipping management computer system over a global communications network using a respective user client computer device, and wherein each respective user client computer device is adapted for communication with the global communications network;

in response to each respective input, apply a set of carrier-specific shipping location rules for each carrier of a plurality of carriers to a respective default shipping location associated with the respective user and to the set of parcel specifications input by the respective user;

for each carrier of the plurality of carriers, determine whether the carrier would support shipping of the particular parcel according to the respective set of shipping

location rules for the carrier as applied to the parcel specifications for the particular

parcel and the respective default shipping location associated with the respective user;

and

generate a simultaneous online display of a plurality of delivery services for each

carrier of the plurality of carriers that would support shipping of the particular parcel from

the respective default shipping location.

2.   A shipping management computer system, said shipping management computer

system comprising at least one computer device, wherein said shipping management

computer system is programmed to:

in response to a request by any particular respective user of a plurality of users

to ship a particular respective parcel, identify each carrier of a plurality of carriers that

would support shipping the particular respective parcel from a respective user-specific

default shipping location that is associated with the particular respective user, wherein

each carrier of a plurality of carriers that would support shipping the particular

respective parcel from the respective user-specific default shipping location is identified

according a respective set of shipping location rules for the carrier as applied to the

respective default shipping location associated with the respective user, wherein each

respective user accesses the computer system over a global communications network

using a respective client computer device, and wherein each respective user client

computer device is adapted for communication with the global communications network;

and

generate a simultaneous online display comprising an identification of a plurality

of delivery services for each carrier of the plurality of carriers that would support

shipping of the particular respective parcel from the respective user-specific default

shipping location.

3.   A shipping management computer system, said shipping management computer

system comprising at least one computer device, wherein said shipping management

computer system is programmed to:

collect as a respective default shipping location for a respective particular user of

a plurality of users, a user input from the respective particular user of a respective

identification of a default shipping location from which respective parcels would be

shipped by the respective particular user, wherein each respective particular user

accesses the computer system over a global communications network using a

respective client computer device, and wherein each respective user client computer

device is adapted for communication with the global communications network;

store in a database a respective record corresponding to each respective

particular user, each said respective record comprising an identifier for the respective

particular user, and further comprising the respective identification of the default

shipping location for the respective particular user;

for each respective carrier of a plurality of carriers, determine whether the

respective carrier would support shipping of a particular parcel according to a respective

set of shipping location rules for the respective carrier as applied to the respective

default shipping location input by the respective particular user; and

generate a simultaneous online display identifying a plurality of delivery services

for each respective carrier of the plurality of carriers that would support shipping of the

particular parcel from the respective default shipping location.

4.   The shipping management computer system of claim 3, said shipping

management computer system further programmed to:

collect as parcel specifications for the particular parcel, user input from the

respective particular user, wherein the parcel specifications comprise at least one of: a

package type, a set of package dimensions, or a package weight of the particular

parcel.

5.   The shipping management computer system of claim 4, said shipping

management computer system further programmed to:

apply a respective set of shipping location rules for each respective carrier of a

plurality of carriers to the respective default shipping location and the parcel

specifications, input by the respective particular user.

6.   The shipping management computer system of claim 5, said shipping

management computer system further programmed to:

for each respective carrier of the plurality of carriers, determine whether the respective carrier would support shipping of the particular parcel according to the respective set of shipping location rules for the respective carrier as applied to the parcel specifications for the particular parcel and the respective default shipping location input by the respective particular user.

7.   The shipping management computer system of claim 6, said shipping management computer system further programmed to:

calculate a respective service-specific, carrier-specific shipping rate for shipping the particular parcel for each respective service of a plurality of services offered by each respective carrier of the plurality of carriers, said respective service-specific, carrier-specific shipping rate calculated according to the respective set of shipping location rules for each respective carrier, and according to a respective set of pricing rules for each respective service offered by each respective carrier as applied to the parcel specifications for the particular parcel and the respective default shipping location.

8.   A method using a computer system for managing shipping of a plurality of parcels shipped by any one carrier of a plurality of carriers, wherein said computer system comprises at least one computer device, the method comprising:

receiving from each respective user of a plurality of users, a respective input of a set of parcel specifications for shipping a respective particular parcel, wherein each respective user accesses the shipping management computer system over a global

communications network using a respective user client computer device, and wherein each respective user client computer device is adapted for communication with the global communications network;

in response to each respective input, applying a set of carrier-specific shipping location rules for each carrier of a plurality of carriers to a respective default shipping location associated with the respective user and to the set of parcel specifications input by the respective user;

for each carrier of the plurality of carriers, determining whether the carrier would support shipping of the particular parcel according to the respective set of shipping location rules for the carrier as applied to the parcel specifications for the particular parcel and the respective default shipping location associated with the respective user; and

generating a simultaneous online display of a plurality of delivery services for each carrier of the plurality of carriers that would support shipping of the particular parcel from the respective default shipping location.

9. A method using a computer system for managing shipping of a plurality of parcels shipped by any one carrier of a plurality of carriers, wherein said computer system comprises at least one computer device, the method comprising:

in response to a request by any particular respective user of a plurality of users to ship a particular respective parcel, identifying each carrier of a plurality of carriers that would support shipping the particular respective parcel from a respective user-specific

default shipping location that is associated with the particular respective user, wherein

each carrier of a plurality of carriers that would support shipping the particular

respective parcel from the respective user-specific default shipping location is identified

according a respective set of shipping location rules for the carrier as applied to the

respective default shipping location associated with the respective user, wherein each

respective user accesses the computer system over a global communications network

using a respective client computer device, and wherein each respective user client

computer device is adapted for communication with the global communications network;

and

generating a simultaneous online display comprising an identification of a

plurality of delivery services for each carrier of the plurality of carriers that would support

shipping of the particular respective parcel from the respective user-specific default

shipping location.

10. A method using a computer system for managing shipping of a plurality of

parcels shipped by any one carrier of a plurality of carriers, wherein said computer

system comprises at least one computer device, the method comprising:

collecting as a respective default shipping location for a respective particular user

of a plurality of users, a user input from the respective particular user of a respective

identification of a default shipping location from which respective parcels would be

shipped by the respective particular user, wherein each respective particular user

accesses the computer system over a global communications network using a

respective client computer device, and wherein each respective user client computer device is adapted for communication with the global communications network;

storing in a database a respective record corresponding to each respective particular user, each said respective record comprising an identifier for the respective particular user, and further comprising the respective identification of the default shipping location for the respective particular user;

for each respective carrier of a plurality of carriers, determining whether the respective carrier would support shipping of a particular parcel according to a respective set of shipping location rules for the respective carrier as applied to the respective default shipping location input by the respective particular user; and

generating a simultaneous online display identifying a plurality of delivery services for each respective carrier of the plurality of carriers that would support shipping of the particular parcel from the respective default shipping location.

15.   A computer program product embodying computer program instructions for execution by a computer system for managing shipping of a plurality of parcels shipped by any one carrier of a plurality of carriers, the computer program product comprising:

a set of program instructions for receiving from each respective user of a plurality of users, a respective input of a set of parcel specifications for shipping a respective particular parcel, wherein each respective user accesses the shipping management computer system over a global communications network using a respective user client computer device, and wherein each respective user client computer device is adapted

for communication with the global communications network;

a set of program instructions for applying, in response to each respective input, a set of carrier-specific shipping location rules for each carrier of a plurality of carriers to a respective default shipping location associated with the respective user and to the set of parcel specifications input by the respective user;

a set of program instructions for determining, for each carrier of the plurality of carriers, whether the carrier would support shipping of the particular parcel according to the respective set of shipping location rules for the carrier as applied to the parcel specifications for the particular parcel and the respective default shipping location associated with the respective user; and

a set of program instructions for generating a simultaneous online display of a plurality of delivery services for each carrier of the plurality of carriers that would support shipping of the particular parcel from the respective default shipping location.

16.   A computer program product embodying computer program instructions for execution by a computer system for managing shipping of a plurality of parcels shipped by any one carrier of a plurality of carriers, the computer program product comprising:

a set of program instructions for identifying, in response to a request by any particular respective user of a plurality of users to ship a particular respective parcel, each carrier of a plurality of carriers that would support shipping the particular respective parcel from a respective user-specific default shipping location that is associated with the particular respective user, wherein each carrier of a plurality of

carriers that would support shipping the particular respective parcel from the respective user-specific default shipping location is identified according a respective set of shipping location rules for the carrier as applied to the respective default shipping location associated with the respective user, wherein each respective user accesses the computer system over a global communications network using a respective client computer device, and wherein each respective user client computer device is adapted for communication with the global communications network; and

a set of program instructions for generating a simultaneous online display comprising an identification of a plurality of delivery services for each carrier of the plurality of carriers that would support shipping of the particular respective parcel from the respective user-specific default shipping location.

17. A computer program product embodying computer program instructions for execution by a computer system for managing shipping of a plurality of parcels shipped by any one carrier of a plurality of carriers, the computer program product comprising:

a set of program instructions for collecting as a respective default shipping location for a respective particular user of a plurality of users, a user input from the respective particular user of a respective identification of a default shipping location from which respective parcels would be shipped by the respective particular user, wherein each respective particular user accesses the computer system over a global communications network using a respective client computer device, and wherein each

respective user client computer device is adapted for communication with the global

communications network;

a set of program instructions for storing in a database a respective record

corresponding to each respective particular user, each said respective record

comprising an identifier for the respective particular user, and further comprising the

respective identification of the default shipping location for the respective particular

user;

a set of program instructions for determining, for each respective carrier of a

plurality of carriers, whether the respective carrier would support shipping of a particular

parcel according to a respective set of shipping location rules for the respective carrier

as applied to the respective default shipping location input by the respective particular

user; and

a set of program instructions for generating a simultaneous online display

identifying a plurality of delivery services for each respective carrier of the plurality of

carriers that would support shipping of the particular parcel from the respective default

shipping location.

18.   The computer program product of Claim 17, the computer program product

further comprising:

a set of program instructions for collecting as parcel specifications for the

particular parcel, user input from the respective particular user, wherein the parcel

specifications comprise at least one of: a package type, a set of package dimensions, or a package weight of the particular parcel.

19.   The computer program product of Claim 18, said computer program product further comprising:

a set of program instructions for applying a respective set of shipping location rules for each respective carrier of a plurality of carriers to the respective default shipping location and the parcel specifications, input by the respective particular user.

20.   The computer program product of Claim 19, said computer program product further comprising:

a set of program instructions for determining, for each respective carrier of the plurality of carriers, whether the respective carrier would support shipping of the particular parcel according to the respective set of shipping location rules for the respective carrier as applied to the parcel specifications for the particular parcel and the respective default shipping location input by the respective particular user.

21.   The computer program product of Claim 20, said computer program product further comprising:

a set of program instructions for calculating a respective service-specific, carrier-specific shipping rate for shipping the particular parcel for each respective service of a plurality of services offered by each respective carrier of the plurality of carriers, said

respective service-specific, carrier-specific shipping rate calculated according to the respective set of shipping location rules for each respective carrier, and according to a respective set of pricing rules for each respective service offered by each respective carrier as applied to the parcel specifications for the particular parcel and the respective default shipping location.

EVIDENCE APPENDIX (37 C.F.R. §41.37(c)(1)(ix) heading)

A copy of Nicholls et al. (U.S. Patent No. 5,485,369; "*Nicholls*") as relied on in the final Office Action dated August 17, 2006 is attached hereto.

A copy of Kara (U.S. Patent No. 6,233,568; "*Kara*") as relied on in the final Office Action dated August 17, 2006 is attached hereto.

A copy of Thiel (U.S. Patent No. 5,699,258; "*Thiel*") as relied on in the final Office Action dated August 17, 2006 is attached hereto.

U.S. Express Mail No. ED329501372US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
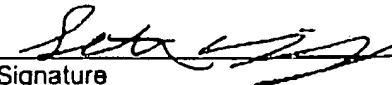AND
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Applicant(s): David Allison Bennett, et al.	Technology Center: 3600
Serial No.: 09/684,871	Group Art Unit: 3629
Filed: October 6, 2000	Examiner: Webb, Jamisue A.
Title: APPARATUS, SYSTEMS AND METHODS FOR ONLINE, MULTI-CARRIER, MULTI-SERVICE PARCEL SHIPPING MANAGEMENT FEATURING SHIPPING LOCATION COMPARISON ACROSS MULTIPLE CARRIERS	
Attorney Docket No.: PSTM0003/MRK	

STATEMENT UNDER 37 C.F.R. §3.73(b)

STAMPS.COM INC. is the owner of an undivided whole interest in common with ISHIP INC. in the instant application. Documentary evidence of the chain of title In accordance with 37 C.F.R. 3.73 (b)(1)(ii) is recorded: 1.) in an Assignment of the entire right, title and interest from the Inventors named in the instant application to STAMPS.COM INC. as recorded by the Assignment Division of the United States Patent and Trademark Office on March 9, 2001 on Reel No. 011630 and Frame No. 0178; and 2.) in a subsequent Intellectual Property Joint Ownership Agreement Notice of Assignment identifying both STAMPS.COM INC. and ISHIP INC. as Assignees of an undivided whole interest in common in all rights title and interest in and to the instant application as recorded by the Assignment Division of the United States Patent and Trademark Office on March 26, 2004 on Reel No. 014466 and Frame No. 0275.

The undersigned is empowered to act on behalf of STAMPS.COM INC.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent Issued thereon.

Signature	Date: January 12, 2006
SETH WEISBERG	VP + GENERAL COUNSEL
Typed or printed name	Title
(310) 482-5808	
Telephone Number	

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
AND
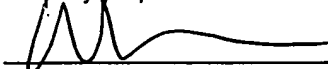BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Applicant(s): David Allison Bennett, et al.	Technology Center: 3600
Serial No.: 09/684,871	Group Art Unit: 3629
Filed: October 6, 2000	Examiner: Webb, Jamisue A.
Title: APPARATUS, SYSTEMS AND METHODS FOR ONLINE, MULTI-CARRIER, MULTI-SERVICE PARCEL SHIPPING MANAGEMENT FEATURING SHIPPING LOCATION COMPARISON ACROSS MULTIPLE CARRIERS	
Attorney Docket No.: PSTM0003/MRK	

STATEMENT UNDER 37 C.F.R. §3.73(b)

ISHIP INC. is the owner of an undivided whole interest in common with STAMPS.COM INC. in the instant application. Documentary evidence of the chain of title in accordance with 37 C.F.R. 3.73 (b)(1)(ii) is recorded: 1.) in an Assignment of the entire right, title and interest from the Inventors named in the instant application to STAMPS.COM INC. as recorded by the Assignment Division of the United States Patent and Trademark Office on March 9, 2001 on Reel No. 011630 and Frame No. 0178; and 2.) in a subsequent Intellectual Property Joint Ownership Agreement Notice of Assignment identifying both STAMPS.COM INC. and ISHIP INC. as Assignees of an undivided whole interest in common in all rights title and interest in and to the instant application as recorded by the Assignment Division of the United States Patent and Trademark Office on March 26, 2004 on Reel No. 014466 and Frame No. 0275.

The undersigned is empowered to act on behalf of ISHIP INC.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

_____
Signature

_____
Typed or printed name
WT Davis

_____
Telephone Number
858 882-5766

_____
Date
1/9/07

_____
Title
VP & Gen Mgr

RELATED PROCEEDINGS APPENDIX (37 C.F.R. §41.37(c)(1)(xi) heading)

1.   A copy of the Notice of Panel Decision from Pre-Appeal Brief Review indicating that Application No. 09/684,861 (Attorney Docket No. PSTM0024/MRK) remains on appeal, is attached hereto.

2.   A copy of the Notice of Panel Decision from Pre-Appeal Brief Review indicating that Application No. 09/680,654 (Attorney Docket No. PSTM0015/MRK) remains on appeal, is attached hereto.

3.   A copy of the Notice of Panel Decision from Pre-Appeal Brief Review, indicating that Application No. 09/685,077 (Attorney Docket No. PSTM0020/MRK) remains on appeal, is attached hereto.

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/684,861	10/06/2000	Paul Bilibin	PSTM0024/MRK	2827

29524	7590	04/18/2006

KHORSANDI PATENT LAW GROUP, A.L.C.
140 S. LAKE., SUITE 312
PASADENA, CA 91101-4710

EXAMINER
VAN DOREN, BETH

ART UNIT	PAPER NUMBER
3623	

DATE MAILED: 04/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

-139-

PTO-90C (Rev. 10/03)

Application Number	Application/Control No.	Applicant(s)/Patent under Reexamination
[barcode]	09/684,861	BILIBIN ET AL.
	Beth Van Doren	Art Unit 3623

Document Code - AP.PRE.DEC	

Notice of Panel Decision from Pre-Appeal Brief Review

[barcode]

This is in response to the Pre-Appeal Brief Request for Review filed <u>3/20/06</u>.

1. ☐ **Improper Request** – The Request is improper and a conference will not be held for the following reason(s):

   ☐ The Notice of Appeal has not been filed concurrent with the Pre-Appeal Brief Request.
   ☐ The request does not include reasons why a review is appropriate.
   ☐ A proposed amendment is included with the Pre-Appeal Brief request.
   ☐ Other: .

   The time period for filing a response continues to run from the receipt date of the Notice of Appeal or from the mail date of the last Office communication, if no Notice of Appeal has been received.

2. ☒ **Proceed to Board of Patent Appeals and Interferences** – A Pre-Appeal Brief conference has been held. The application remains under appeal because there is at least one actual issue for appeal. Applicant is required to submit an appeal brief in accordance with 37 CFR 41.37. The time period for filing an appeal brief will be reset to be one month from mailing this decision, or the balance of the two-month time period running from the receipt of the notice of appeal, whichever is greater. Further, the time period for filing of the appeal brief is extendible under 37 CFR 1.136 based upon the mail date of this decision or the receipt date of the notice of appeal, as applicable.

   ☒ The panel has determined the status of the claim(s) is as follows:
   Claim(s) allowed: _____.
   Claim(s) objected to: _____.
   Claim(s) rejected: *1-13 & 15-17 &19-23*.
   Claim(s) withdrawn from consideration: _____.

3. ☐ **Allowable application** – A conference has been held. The rejection is withdrawn and a Notice of Allowance will be mailed. Prosecution on the merits remains closed. No further action is required by applicant at this time.

4. ☐ **Reopen Prosecution** – A conference has been held. The rejection is withdrawn and a new Office action will be mailed. No further action is required by applicant at this time.

All participants:

(1) *Beth Van Doren*.

(2) *Susanna Diaz*.

(3) *Tariq Hafiz*.

(4) _____.

UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/680,654	10/06/2000	David Allison Bennett	PSTM0015/MRK	9943

29524	7590	05/19/2006

KHORSANDI PATENT LAW GROUP, A.L.C.
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PASADENA, CA 91101-4710

EXAMINER
WEBB, JAMISUE A

ART UNIT	PAPER NUMBER
3629	

DATE MAILED: 05/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Application Numb	Application/Control No.	Ar ant(s)/Patent under Re. .mination
[barcode]	09/680,654	BENNETT ET AL.
	John G. Weiss	**Art Unit** 3629

Document Code - AP.PRE.DEC	

Notice of Panel Decision from Pre-Appeal Brief Review

[barcode]

This is in response to the Pre-Appeal Brief Request for Review filed _5/2/06_.

1. ☐ **Improper Request** – The Request is improper and a conference will not be held for the following reason(s):

    ☐ The Notice of Appeal has not been filed concurrent with the Pre-Appeal Brief Request.
    ☐ The request does not include reasons why a review is appropriate.
    ☐ A proposed amendment is included with the Pre-Appeal Brief request.
    ☐ Other: .

The time period for filing a response continues to run from the receipt date of the Notice of Appeal or from the mail date of the last Office communication, if no Notice of Appeal has been received.

2. ☒ **Proceed to Board of Patent Appeals and Interferences** – A Pre-Appeal Brief conference has been held. The application remains under appeal because there is at least one actual issue for appeal. Applicant is required to submit an appeal brief in accordance with 37 CFR 41.37. The time period for filing an appeal brief will be reset to be one month from mailing this decision, or the balance of the two-month time period running from the receipt of the notice of appeal, whichever is greater. Further, the time period for filing of the appeal brief is extendible under 37 CFR 1.136 based upon the mail date of this decision or the receipt date of the notice of appeal, as applicable.
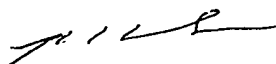
    ☒ The panel has determined the status of the claim(s) is as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: _1-21, 26-52 and 57-70_.
Claim(s) withdrawn from consideration: _____.

3. ☐ **Allowable application** – A conference has been held. The rejection is withdrawn and a Notice of Allowance will be mailed. Prosecution on the merits remains closed. No further action is required by applicant at this time.
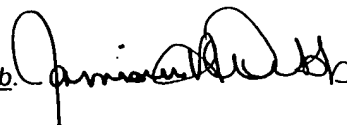
4. ☐ **Reopen Prosecution** – A conference has been held. The rejection is withdrawn and a new Office action will be mailed. No further action is required by applicant at this time.

All participants:

(1) _John G. Weiss_.

(2) _Dean Nguyen_.

(3) _Jami Webb_.

(4)_____.

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U.S. Patent and Trademark Office   Part of Paper No. 51606

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/685,077	10/06/2000	Paul Bilibin	PSTM0020/MRK/STM	3148

29524   7590   07/21/2006

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140 S. LAKE., SUITE 312
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EXAMINER
WEBB, JAMISUE A

ART UNIT	PAPER NUMBER
3629	

DATE MAILED: 07/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

Application Number	Application/Control No.	A. .cant(s)/Patent under Reexamination
[barcode]	09/685,077	BILIBIN ET AL.
	John G. Weiss	**Art Unit** 3629

Document Code - AP.PRE.DEC

Notice of Panel Decision from Pre-Appeal Brief Review

[barcode]

This is in response to the Pre-Appeal Brief Request for Review filed <u>6/15/06</u>.

1. ☐ **Improper Request** – The Request is improper and a conference will not be held for the following reason(s):

    ☐ The Notice of Appeal has not been filed concurrent with the Pre-Appeal Brief Request.
    ☐ The request does not include reasons why a review is appropriate.
    ☐ A proposed amendment is included with the Pre-Appeal Brief request.
    ☐ Other: .

The time period for filing a response continues to run from the receipt date of the Notice of Appeal or from the mail date of the last Office communication, if no Notice of Appeal has been received.

2. ☒ **Proceed to Board of Patent Appeals and Interferences** – A Pre-Appeal Brief conference has been held. The application remains under appeal because there is at least one actual issue for appeal. Applicant is required to submit an appeal brief in accordance with 37 CFR 41.37. The time period for filing an appeal brief will be reset to be one month from mailing this decision, or the balance of the two-month time period running from the receipt of the notice of appeal, whichever is greater. Further, the time period for filing of the appeal brief is extendible under 37 CFR 1.136 based upon the mail date of this decision or the receipt date of the notice of appeal, as applicable.

    ☒ The panel has determined the status of the claim(s) is as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: <u>1-7, 58-83</u>.
Claim(s) withdrawn from consideration: _____.

3. ☐ **Allowable application** – A conference has been held. The rejection is withdrawn and a Notice of Allowance will be mailed. Prosecution on the merits remains closed. No further action is required by applicant at this time.

4. ☐ **Reopen Prosecution** – A conference has been held. The rejection is withdrawn and a new Office action will be mailed. No further action is required by applicant at this time.

All participants:

(1) <u>John G. Weiss</u>.   (3)<u>Jamisue Webb</u>.

(2) <u>Dean Nguyen</u>.   (4)_____.

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